

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 22, 2010 has been entered.

### ***Response to Amendment***

2. This Office Action is in response to the Amendment filed on November 22, 2010. The Amendment did not add nor cancel any claims, but did amend Claims 2, 14, and 20. Claims 1, 6, 10, and 11 were previously cancelled. Thus, the currently pending claims considered below are Claims 2-5, 7-9, and 12-20.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 14-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

a. With respect to Claim 14, the preamble of the claim recites a system, indicating structure, means plus function or Hardware. The body of the claim identifies the system comprising “a web site host” that performs a series of steps. The Specification states the “The e-commerce provider’s web site is hosted by a web host 11, using known computing and storage devices” (page 5, lines 20-22). Thus, it appears that the claimed web site host is the web host 11. The Specification also states that “web host 11 is programmed with web site software” that performs various steps (page 5, lines 23-24). Thus web host 11 is not the entity that is “using known computing and storage devices”, but a computing device. However, a device by itself is not a system, but merely a device. A system consists of a plurality of devices connected and/or used together. Based on the section of the Specification referred to above and the paragraph on page 6, lines 4-9, the system is comprised of several components: the web host 11, web site software, customer “raw” data database 14, customer models database 12, and content alternative database 13. In order to be statutory the claim should recite all the components needed to allow one having ordinary skill in the art at the time the invention was made to make and use the system. For example, Claim 14 could be amended to read:

“14 ..., the system comprising:

a customer data database storing user data ...;

a models database storing a number of customer models;

a web content database storing a number of ... ; and

a web site host computing device programmed with web site software that when executed causes the web site host to perform the steps of:

receiving an identifier of a user ...;  
assigning the user to a group ...;  
selecting a web content format ..., and  
downloading the requested web content ...”.

Dependent claims 15-19 do not correct the deficiencies in their parent claim noted above and are, thus, likewise rejected as being directed to non-statutory subject matter.

b. With respect to Claim 20, the preamble recited a device (“web hosting computing device”), whereas the body of the claim merely identifies actions that the device is configured to perform. In order to be statutory the claim should recite all the components needed to allow one having ordinary skill in the art at the time the invention was made to make and use the device. In the instant claim in light of the Specification it appears that the device comprises two parts: the computing device and web browser software that is being executed by the computing device. Thus, the claim could read, for example:

“20 ... A web hosting computing device for providing a web site, comprising:  
a web hosting computing device; and  
web hosting software stored on the web hosting computing device, which when executed causes the web hosting computing device to perform the steps of:  
identifying users ...;

determining Internet service type data ...;  
assigning a specific user ...; and  
responding to a request ...".

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 2-5, 7-9, and 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al (US 2001/0014868) in view of Friedman et al (US 2003/0110293).

Claims 2, 14, and 20: Herz discloses a method, system, and device for providing web content to users, comprising: a plurality of databases and a main computer (page 3, paragraph 0021) programmed to do the steps of:

- a. collecting user data ("*Profiles are collected which characterize shoppers and offers*") (page 4, paragraphs 0031-0034 and page 5, paragraph 0039);
- b. receiving requests for web content from a subset of the users ("*the shopper may browse through an on-line catalog, or may progressively narrow a search by using keywords*") (page 4, paragraph 0036);
- c. accessing portions of the user data corresponding to each user in the subset ("*the system considers not only the shoppers present goals ... and the offer profiles, but also the stored profiles of this shopper*") (page 4, paragraph 0037 and page 8, paragraphs 0112-0137);
- d. grouping users in the subset into user models ("*the shopper database can be compressed by clustering together similar shopper profiles ... all of the shoppers in the same cluster are given the same profile*") (page 2, paragraph 0006; page 4, paragraph 0034; and page 12, paragraph 0155);
- e. selecting web content formats corresponding to the user models (page 4, paragraph 0037 - page 5, paragraph 0038); and
- f. downloading the selected web content to a specific user who was grouped into the user model ("*Present selected offers to shopper—By sending text and/or graphics to the shopper's terminal ... the main computer describes the selected offers to the shopper*") (page 4, paragraph 0037 – page 5, paragraph 0038).

While Herz discloses collecting a myriad of types of information about the user, such as demographic, temporal, and type of connection being used, it is not explicitly disclosed that this information would also include determining whether the Internet service (connection) is a broadband service, i.e. what is the bandwidth of the connection. However, Friedman discloses a similar method, system, and device for providing web content to users (page 9, paragraph 0161) that also the *"bandwidth available at the source, destination, or intermediate nodes, connection speeds of links between nodes or connection speed at the source"* (page 2, paragraph 0015) and then *"can dynamically adapt and tailor Internet advertising for targeting specific Internet users based on their geographic location and/or connection speed"* (page 9, paragraph 0161), thus enabling the system *"to provide media-rich content to users that have sufficient bandwidth"* (page 9, paragraph 0158). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Herz to also collect data identifying whether or not the user's Internet service was broadband or not, i.e. the available bandwidth and connection speed. One would have been motivated to collect this information about the user in order to select an appropriate format for the content being downloaded to the user, e.g. media-rich if the connection is broadband and media-poor (e.g. text-only) for a slower connection with less bandwidth as discussed by Friedman.

Claims 3-5, 7-9, 15, and 16: Herz and Friedman disclose a method and system as in Claims 2 and 14 above, and Herz further discloses determining the user's interests, preferences, emotional state, shopping goals, and shopping behavior (page 5, paragraph 0039; page 12, paragraphs 0155-0158; and page 26, paragraph 0258).

While it is not explicitly disclosed that the user's goals are cost focused, savings focused, or technology focused, these would be common goals of shoppers and easily determined from the information being tracked by Herz. Furthermore, the selection of what type of user information is tracked and used for targeting the content is a design decision of the entity setting up the system. For example, if the system is being run by a manufacturer or merchant of pet food, then it would be obvious that the system would be set up to track the type, breed, age, etc. of pets owned by the user. If, on the other hand, the system was being run by an electronics manufacturer or merchant, it would have been obvious that the system would be set up to track the type and capabilities of electronic equipment owned by the user. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Herz to include in the user database information about whether the user's goal was to save money, to always buy the lowest cost product, to have the latest technology, or any other goal of the user. One would have been motivated to collect this type of goal information in order to better target (format) the selected content, e.g. to offer the more expensive, but latest technology to a technology focused user or to offer an older, but cheaper, technology to a savings focused user; thus, increasing the likelihood that the offer would be accepted by the user. The Examiner notes that since the targeting data is used to

select an appropriate content (e.g. ad), the format of the ad inherently includes the same targeting data, e.g. whether it is directed to a cost-focused user, a technology-focused user, etc.

Claims 12 and 19: Herz and Friedman disclose a method and system as in Claims 2 and 14 above, and Herz further discloses the grouping occurs while the users are on line to the web site ("*A group of shoppers with similar shopper profiles or offer demand summaries can be thought of as a buyers' club or a 'mini'-market that is assembled automatically, on an ad hoc basis*") (page 4, paragraph 0034 and page 31, paragraph 0292).

Claims 13 and 17: Herz and Friedman disclose a method and system as in Claims 2 and 14 above, and Herz further discloses collecting user data while the particular user is on line to a web site ("*Records of the information requested and the products purchased by the shopper are incrementally collected during shopping*"; "*As the shopper considers and selects products and offers in steps 3 and 5 above, the system monitors the shoppers interest in various offers. The main computer uses this information to update the shopper's profile in the shopper database*") (page 4, paragraphs 0031-0034 and page 5, paragraph 0039).



Claim 18 Herz and Friedman discloses a system as in Claim 14 above, and Herz further discloses at least one of the web content formats is a default format ("*These global weights are used as a default initial setting for a new shopper who has not yet provided any feedback*"; "*the 72 offers may be conveniently regarded as a single, parameterized, generic, 'tube of Crest toothpaste' offer*"; "*For shoppers for whom no purchase history is available, promotions may be generated by using a 'typical' purchase history*") (page 12, paragraph 0155; page 16, paragraph 0178; page 22, paragraph 0246; and page 28, paragraph 0269).

### ***Response to Arguments***

8. Applicant's arguments filed November 22, 2010 have been fully considered but they are not persuasive.

a. The Applicant argues in reference to Claim 2 (pages 6-7) that "Roth's IP data does not indicate whether an Internet service of a user is a broadband service". However, Roth has not been cited in the above reference as disclosing this feature, thus rendering the argument moot. As noted in the rejection of Claim 2 above, Friedman discloses determining the amount of bandwidth available and modifying or selecting advertisement (content) based thereon, e.g. sending a text-only document to a device using a low-bandwidth connection (e.g. a PDA) or a full multi-media document to a device using a high bandwidth connection (broadband) (e.g. a desktop computer). Since Herz discloses collecting all kinds of information about the user to include the type of connection, it would have been obvious that this connection information could include

the amount of available bandwidth, i.e. whether or not the connection is broadband, in order to allow Herz to select or modify the content according to the bandwidth as disclosed by Friedman.

b. The Applicant argue in reference to Claims 14 and 20 (page7) that "Friedman teaches away from the use of user data to group a user". However, this is a moot argument since the primary reference Herz already shows grouping the users according to their profile information. Friedman was used to show that determining the type of connection as to whether it is broadband or not was known at the time of the invention and that it would have been obvious for Herz to also collect and use this information when selecting a targeted response to the request.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES W. MYHRE whose telephone number is (571)272-6722. The examiner can normally be reached on Monday through Thursday 6:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JWM  
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/James W Myhre/  
Primary Examiner, Art Unit 3688